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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Adrianne Lewis

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05/07/2004

IP DEPARTMENT OF PIPER RUDNICK LLP  
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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/981,156

Applicant(s)

LEWIS, ADRIANNE

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- ☐ Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on March 4, 2004 under 37 CFR 1.116 amending Claims 1, 6, 8, 14, 18, 23, 25, 30, 32, and 36 and adding new Claim 42 has been considered but is ineffective to overcome the Von Kohorn (5,916,024) reference.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (5,916,024).

Claims 1, 8, 13, 18, 25, 32, and 42: Von Kohorn discloses a system, method, and computer program for advertising on a computer network, comprising:

- a. Presenting an initial advertisement relating to a specific product or service (col 155, line 65 – col 156, line 1);
- b. Prompting a player to access the advertisement by selecting an icon or link;

c. Incorporating one or more additional advertisements into an interactive game (col 141, line 58 – col 142, line 20);

d. Allowing the player to play the game based on the player's interaction with the initial advertisement (col 1, line 25 - col 10, line 43).

e. Tracking information relating to the highest scores for at least one time period (col 120, lines 43-52; col 121, lines 10-59; col 127, lines 39-41; col 144, lines 34-37; col 156, lines 45-49; col 157, lines 34-55; col 159, lines 29-35; and col 161, lines 52-55); and

f. Awarding at least one player with the highest score with a prize which may be used to obtain the advertised merchandise or service (col 120, lines 43-52; col 121, lines 10-59; col 127, lines 39-41; col 144, lines 34-37; col 156, lines 45-49; col 157, lines 34-55; col 159, lines 29-35; and col 161, lines 52-55).

The Examiner notes that Von Kohorn discloses that a plurality of products (i.e. advertisements) are presented to the user, who selects one of the products (col 79, lines 35-41) "by touching numbered buttons...or by other means" (col 85, lines 31-32) and is then directed to the game in order to "win" or qualify for some type of incentive for the selected product, such as a discount, coupon, free merchandise, etc. (col 102, lines 20-25). Thus, the product is selected prior to the user beginning to play the interactive game. Von Kohorn also explicitly discloses presenting the claimed "initial advertisement" by stating that "TV viewers/shoppers can be alerted to special promotions, deals, sales, free sample opportunities, and to contests, prizes and awards by televised announcement preceding the video game show (col 155, line 65 – col 156,

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line 1). Von Kohorn also discloses that the user is presented with information about the nature of the game (i.e. an advertisement to entice the user to play the game) prior to entering, such as the time when the game may start (col 92, lines 14-26), thus, again discloses an "initial advertisement". Von Kohorn also discloses that the game can consist of one or more additional advertisements being displayed to the user during the game, who then responds to one or more queries about advertisement(s) in order to win the game, increase the player's score, or win a discount coupon for the product (col 141, line 58 – col 142, line 20).

The Examiner notes that the disclosure that the user may make a selection through the response device by touching numbered button or by other means would encompass other known input means, such as a mouse, track ball, joystick, touch screen, etc. as discussed by Von Kohorn (col 133, lines 31-38). The presentation of additional information about the product or service to the user when a selection is made implies that the selection is "linked" to the additional information files.

Claims 2, 9, 19, and 26: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the additional advertisement is an active element of the game (col 1, line 25 - col 10, line 43 and col 47, lines 11-15).

Claims 3, 10, 20, 27, and 34: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 26 and 32 above, and further discloses that the game is a trivia game and that the additional

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advertisement provides clues to the trivia questions (col 1, line 25 - col 10, line 43; col 43, lines 1-15; and col 119, lines 4-8).

Claims 4, 11, 21, and 28: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 27 above, and further discloses prompting the player to access advertisements on the advertiser's website in order to progress in the game (col 1, line 25 - col 10, line 43).

Claims 5, 12, 22, 29, and 35: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 28, and 32 above, and further discloses providing one or more prizes to winning players (col 1, line 25 - col 10, line 43).

Claims 6, 14, 15, 23, 30, and 36: Von Kohorn discloses a system, method, and computer program for advertising on a computer network including the steps in Claims 1, 8, 13, 18, 29, and 32 above, and further discloses compiling demographic information on the player and targeting the advertisement based on the player's demographic information (col 1, line 25 - col 10, line 43 and col 137, lines 40-67).

Claims 7, 16, 24, 31, and 33: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 30, and 32 above, and further discloses that the game is one of a trivia game, bingo, dominoes, casino games, card games, tic-tac-toe, or jigsaw puzzle (col 1, line 25 - col 10, line 43 and col 119, lines 4-8).

Claim 17: Von Kohorn discloses a method for advertising on a computer network as in Claim 8 above, and further discloses placing the game into a computer advertising spot (col 1, line 25 - col 10, line 43).

Claims 37-40: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the initial advertisement is accessible independent of accessing an advertiser's website. Von Kohorn explicitly discloses that the advertisements may be downloaded to the user's remote device prior to the user accessing the advertisement or game program. This downloading may be from online or through the use of a memory disk distributed to the user (col 29, lines 27-34; col 79, line 62 - col 80, line 7; and col 140, lines 59-67). Thus, when the user begins, an initial advertisement is presented to the user without necessitating the user connecting to the advertiser's website.

Claim 41: Von Kohorn discloses a method for advertising on a computer network as in Claim 4 above, and further discloses that the advertising material is one of images of products, marketing messages, logos, taglines, and jingles (col 18, lines 23-29 and col 47, lines 9-19).

### ***Response to Arguments***

4. Applicant's arguments filed March 4, 2004 have been fully considered but they are not persuasive.

a. The Applicant argues in reference to Claim 1 that Von Kohorn does not disclose an "advertising image or message which is part of the quiz game as required by claim 1" (page 14). The Examiner notes that in the rejection of Claim 1 (et al) above, additional citations from the reference have been made which directly disclose this feature.

b. The Applicant further argues in reference to Claim 1 that Von Kohorn does not disclose that "high scores are tracked and only high scorers in a specified time period of the interactive game are rewarded" (page 15). The Examiner notes that this newly added feature is explicitly disclosed by Von Kohorn as discussed in the above rejection.

c. The Applicant also argues in reference to claims 8, 18, 25, and 32 that Von Kohorn does not disclose that the player is required "to play an interactive game... multiple times in order to obtain a prize" (page 15). The Examiner notes that Von Kohorn explicitly discloses maintaining the scores of players through multiple games or during breaks in the game (which could be hours or days) as discussed in the rejection of these claims above.

d. The Applicant argues in reference to Claims 6, 14, 23, 30, and 36 that Von Kohorn does not disclose compiling a player's personal information (demographics) and using the information to tailor advertising content for the particular player. The Examiner has cited additional passages in Von Kohorn which discuss compiling demographic information about the players. Von Kohorn also discusses tailoring the game, advertisements, and prizes based on such demographics as age and residence. It is particularly noted that the system could tailor all three aforementioned features of



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the system based on the geographic area (or country) in which the player resides or that differing games and prizes could be offered based on the age of the player (i.e. if the player is a child)(col 152, lines 27-34). Thus, it is disclosed that the games, advertisements, and prizes can be tailored to the players' demographics.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number

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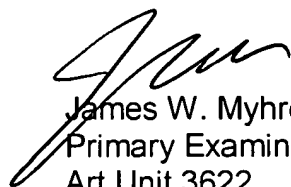
for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

May 6, 2004



James W. Myhre

Primary Examiner

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